

REMARKS

Upon entry of the present amendment, claims 1-9 and 11 will remain pending in the present application. Claims 8 and 9 have been withdrawn from consideration.

Claim 1 has been amended. Claim 10 has been cancelled and rewritten as new claim 11 in order to overcome the rejection under 35 USC § 112, first paragraph. The amendments made herein to the claims do not incorporate new matter into the application as originally filed.

Proper consideration of each of the pending claims (i.e., claims 1-9 and 11) is respectfully requested at present, as is entry of the present amendment.

Election/Restriction

At “*Disposition of Claims*” on page 1 of the Office Action, it is stated that claim 8 and 9 are withdrawn from consideration. On the other hand, at page 2 of the Office Action, the Examiner has indicated that newly submitted “claims 7 and 8” have been withdrawn from consideration as being directed to an invention other than the invention “elected” due to the presentation and examination of “method” claims. Claims 8 and 9 are directed to “a product”, and Claims 7 is directed to “a method.”

Thus, Applicants respectfully submit that “claims 7 and 8” should read “claims 8 and 9” at page 2 of the Office Action.

Claim Rejection under 35 USC § 112, First Paragraph

At page 3 of the outstanding Office Action, claim 10 has been rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement.

In the present amendment, claim 10 has been cancelled and rewritten as new claim 11 in order to overcome this rejection.

Accordingly, Applicants traverse this rejection, and respectfully request reconsideration and withdrawal thereof.

Claim Rejection under 35 U.S.C. §103(a)

At pages 3-6 of the Office Action, claims 1, 2 and 4-7 have been rejected under 35 U.S.C. §103(a) as being obvious over “the admitted prior art” in view of Takuman EP '211 (EP 1 225 211 A2). Further, claims 3 and 10 have been rejected under 35 U.S.C. §103(a) as being obvious over “the admitted prior art” and Takuman EP '211 in further view of Simizu US '140 (US 4,216,140).

Accordingly, Applicants traverse this rejection, and respectfully request reconsideration and withdrawal thereof.

The Admitted Prior Art

One step in any obviousness analysis is to determine the scope and content of the prior art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The term “prior art” as used in section 103 refers at least to the statutory material named in 35 U.S.C. §102. *In re Wertheim*, 646 F.2d 527, 532, 209 USPQ 554, 560 (CCPA 1981). Section 102 is not the only source of section 103 prior art since “admissions” by the applicant in the patent application may also be considered prior art for an obviousness rejection. *See* 37 C.F.R. § 1.106(c); *In re Fout*, 675 F.2d 297, 213 USPQ 532, 535 (CCPA 1982). However, “[m]ere

conclusory statements in the specification, unsupported by objective evidence, are entitled to little weight when the PTO questions the efficacy of those statements.” *In re Greenfield*, 571 F.2d 1185, 197 USPQ 227, 229 (CCPA 1978).

At page 4 of the outstanding Office Action the Examiner characterizes the “admitted prior art” as disclosing a method of preparing an air bag, said method comprising: furnishing a pair of base fabric pieces impregnated and/or coated with silicone rubber; laying the pieces one on the other with the coated surfaces of the pieces inside; applying an adhesive silicone rubber composition as a sealer to the peripheral portions of the base fabric pieces; and bonding or stitching peripheral portions of the pieces together to form a bag. In this regard the Examiner cites page 1, lines 17-30 of the present specification.

At page 1, lines 16-32, the instant specification reads as follows:

BACKGROUND OF THE INVENTION

One typical process for preparing an air bag involves the steps of furnishing a pair of base fabric pieces impregnated and/or coated with silicone rubber, laying the pieces one on the other, with the coated surfaces of the pieces inside, and bonding or stitching peripheral portions of the pieces together to form a bag. An attempt has been made to apply an adhesive silicone rubber composition as a sealer to the peripheral portions of the base fabric pieces prior to bonding or stitching. With the state of the art, it is very difficult to bond an uncured silicone rubber composition to once cured silicone rubber.

Applicants previously proposed an addition reaction curing type silicone rubber composition filled with calcium carbonate as an air bag sealer (see JP-A 2003-253121 corresponding to US2003-0162875). It would be desirable to have an air bag sealer having further improved adherence. (Emphasis added)

A review of the passage referenced by the Examiner, as well as the entire specification, reveals that the Examiner has mischaracterized the “admitted prior art”. The description generally provides a “typical” process in the art at page 1, lines 17-22 of the specification.

However, in the discussion of “[a]n attempt has been made to apply an adhesive silicone rubber composition as a sealer to the peripheral portions of the base fabric pieces prior to bonding or stitching. With the state of the art, it is very difficult to bond an uncured silicone rubber composition to once cured silicone rubber,” this is simply referring to the object of the invention and “an attempt” is the present inventors’ own secret attempt, which is not prior art. It is submitted that this explanation is sufficient. However, if necessary, applicants are willing to amended the specification to clarify that the underlined phrase is not “prior art” if the application is otherwise in condition for allowance.

Takuman EP '211, Simizu US '140

Takuman EP '211 and Simizu US '140 also fail to disclose or suggest applying as a sealer the specific silicone rubber composition to peripheral portions of the base fabric pieces to be jointed, in a process of preparing an air bag, which is a feature of the present invention as recited in claims 1.

Combination of the Cited References

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine

references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present application, it is submitted that a *prima facie* case of obviousness has not been established, even if the cited references are combined, since none of the cited references provide any teaching, suggestion, or motivation to arrive at the present invention. Specifically, none of the cited references discloses and suggests applying as a sealer the specific silicone rubber composition to peripheral portions of the base fabric pieces to be jointed, in a process of preparing an air bag, which is a feature of the present invention as recited in claims 1.

Accordingly, the present invention (independent claim 1 and dependent claims) is not obvious over the cited references.

CONCLUSION

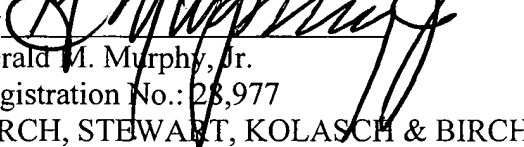
In view of the above amendment and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr., (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: FEB 27 2006

Respectfully submitted,

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